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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,969	01/29/2004	Masaki Takabayashi	TAK-168-USAP	2344

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EXAMINER

SANDY, ROBERT JOHN

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/765,969

Applicant(s)

TAKABAYASHI ET AL.

Examiner

Robert J. Sandy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-10 is/are rejected.
- 7) ☒ Claim(s) 5, 6, 11 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/29/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities:

Page 14, line 1 of the specification, “combing” should be changed to - - combining - -.

Page 15, line 4 of the specification, “combing” should be changed to - - combining - -.

Appropriate correction is required.

Claim Objections

Claims 3, 4, 5, 6, 9, 10, 11, and 12 are objected to because of the following informalities:

In claim 3, line 2, the phrase “a fitting ditch” should be change to - - said fitting ditch - - since antecedent basis for “a fitting ditch” has been established in claim 1, line 7.

In claim 3, line 3, the phrase “a cover body” should be change to - - said cover body - - since antecedent basis for “a cover body” has been established in claim 1, line 3.

In claim 4, line 2, the phrase “a fitting ditch” should be change to - - said fitting ditch - - since antecedent basis for “a fitting ditch” has been established in claim 2, line 8.

In claim 4, line 3, the phrase “a cover body” should be change to - - said cover body - - since antecedent basis for “a cover body” has been established in claim 2, line 3.

In claim 5, line 7, the phrase “an auxiliary plate” should be changed to - - said auxiliary plate - - since antecedent basis for “a recessed auxiliary plate” has been established in claim 5, line 6.

In claim 6, line 18, “combing” should be changed to - - combining - -.

In claim 9, line 1, the preamble phrase “A decorative cover” should be changed to - - An artificial nail cover - - in order to be consistent with the preamble of claim 1.

In claim 9, line 2, the phrase “a fitting ditch” should be change to - - said fitting ditch - - since antecedent basis for “a fitting ditch” has been established in claim 1, line 7.

In claim 9, line 3, the phrase “a cover body” should be change to - - said cover body - - since antecedent basis for “a cover body” has been established in claim 1, line 3.

In claim 10, line 1, the preamble phrase “A decorative cover” should be changed to - - An artificial nail cover - - in order to be consistent with the preamble of claim 2.

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In claim 10, line 2, the phrase "a fitting ditch" should be change to - - said fitting ditch - - since antecedent basis for "a fitting ditch" has been established in claim 2, line 8.

In claim 10, line 3, the phrase "a cover body" should be change to - - said cover body - - since antecedent basis for "a cover body" has been established in claim 2, line 3.

In claim 11, bridging lines 6 and 7, the phrase "an auxiliary plate" should be changed to - - said auxiliary plate - - since antecedent basis for "a recessed auxiliary plate" has been established in line 6.

In claim 12, line 1, the phrase in the preamble "combining decorative" should be changed to read as - - combining a decorative - - for proper grammar.

In claim 12, line 17, "combing" should be changed to - - combining - -.
Appropriate correction is required.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 9 is objected to under 37 CFR 1.75 as being a substantial duplicate of claims 3, and claim 10 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 4. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Applicant is advised that should claims 3 and 4 be found allowable, claims 9 and 10 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

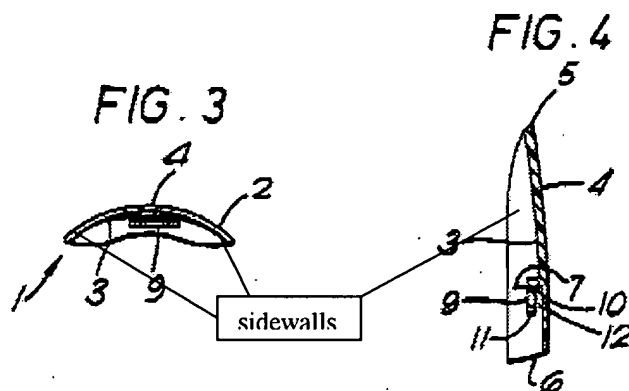
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Aylott, deceased et al. (U. S. Patent No. 5,413,123).

Concerning claims 1, 3, 7 and 9, Aylott ('123) discloses a decorative artificial nail cover (1) which comprises: a cover body (2) extending to an end of the cover with a curved surface like a human nail; and a thin plate wall (9) formed in an inner surface of the cover body and running sideways along the cover body; wherein a fitting ditch (12) is formed on the thin plate wall between the wall and the inner surface of the cover body.

Concerning claims 2, 4, 8 and 10, Aylott ('123) discloses decorative artificial nail cover (1) which comprises: a decorative cover body (2) with a decorative surface (4) and having in a rear portion a pair of side walls (see Figs. 3 and 4 provided herein) directed downward and facing each other; a thin plate wall (9) formed in an inner surface of the cover body and directed toward each side wall; and wherein a fitting ditch (12) is formed on the thin plate wall between the thin plate wall and an inner surface of the cover body.



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Claims 1-4 and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Ogunro (U. S. Patent No. 4,559,055).

Concerning claims 1, 3, 7 and 9, Ogunro ('055) discloses a decorative artificial nail cover (10; see Figures 1-4) which comprises: a cover body (12) extending to an end of the nail cover with a curved surface like a human nail; and a thin plate wall (26) formed in an inner surface of the cover body and running sideways along the cover body; wherein a fitting ditch (recessed area formed by portion 36, See Fig. 3) is formed on the thin plate wall between the wall and the inner surface of the cover body.

Concerning claims 2, 4, 8 and 10, Ogunro ('055) discloses a decorative artificial nail cover (10) which comprises: a cover body (12) having in a rear portion a pair of side walls (22, 24, Fig. 1) directed downward and facing each other, and a decorative surface (of 12); a thin plate wall (26) formed in an inner surface of the cover body and directed toward each side wall; and wherein a fitting ditch (recessed area formed by portion 36) is formed on the thin plate wall between the thin plate wall and an inner surface of the cover body.

Allowable Subject Matter

Claims 5, 6, 11 and 12 would be allowable if rewritten to overcome the claims objections set forth in this Office action.

Concerning claims 5, 6, 11 and 12, the following is a statement of reasons for the indication of allowable subject matter: the prior art of record fails to teach or suggest the clip/clip set having the combination of the claimed clip including a cover attached on the outer surface of the first clipping member of the clip/clip set, the cover having a wall formed in an inner surface of the cover body of the clip/clip set and running sideways along the body cover; a fitting ditch formed on the thin plate wall between the wall and the inner surface of the cover body; the thin plate inserted into the combining window of the first clipping member so that the fitting ditch is to be inserted into an end side of the combining window; and the cover body is to be attached on the outer side of the first clipping member.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Other nail covers are taught by Ogunro (U. S. Patent No. 4,445,234) and Grace et al. (U. S. Patent No. 6,488,506). Other clip devices are taught by:

US 6488506 B2	USPAT	Grace; John et al.
US 6260244 B1	USPAT	Noda; Taizoh
US 5778497 A	USPAT	Noda; Taizo
US 5400483 A	USPAT	Noda; Taizo
US 4086686 A	USPAT	Takabayashi; Teruo
US 3914828 A	USPAT	Noda; Taizo
US 0277700 A	USPAT	C. W. Foster

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J. Sandy whose telephone number is 703-305-7413. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ROBERT J. SANDY
PRIMARY EXAMINER

Robert J. Sandy
Primary Examiner
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